



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/042,686 | 03/14/2000 | David J. Luneau | 1090-006 | 1741 |

7590 09/18/2002

FISH & RICHARDSON PC
225 FRANKLIN STREET
BOSTON, MA 02110-2804

EXAMINER

NGUYEN, LEE

ART UNIT PAPER NUMBER

2683

DATE MAILED: 09/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,686

Applicant(s)

LUNEAU, DAVID J.

Examiner

LEE NGUYEN

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,038,443. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-14 of U.S. Patent 6,038,443 encompass the limitation of claims 1-17 of the present application .

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figa et al. (U.S. 4,924,496) cited in the parent application in view of Blakley (U.S. 4,899,358) cited in the parent application.

Regarding claims 1, 11, Figa discloses a calling party announcement apparatus in fig. 1, comprising: detecting means 12 for detecting the caller's identification signal and central processing means 18 for processing the caller's identification signal corresponding to the identity of the caller. Figa differs from claim 1 of the present invention in that the calling parties number is displayed as opposed to being audibly announced as claimed. Blakley teaches in a caller announcement system to detect a calling party's identity and to audibly announce the caller's identity at the user's telephone set. With this knowledge, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to substitute the visual display technique of Figa with the audible announce concept of Blakley to indicate the caller's identity for a user with visual impairment.

Regarding claims 2-3, Figa as modified also differs from claims 2-3 of the present invention by not specifically disclosing the isolation and reconnection means as claimed. However, Blakley specifically teaches in col. 1, lines 64-67 that "the name is spoken after the called party has answered in response to ringing at the station but before a connection is completed to the caller". When providing the audible announcement concept of Blakley in a local environment, as in Figa, it would have been obvious to one of ordinary skill in the art to isolate the telephone apparatus from the telephone system in order that the caller's identity is audibly announced through the handset without the caller being aware that the user has gone "off-hook" with the telephone, and thus preventing a direct connection between the caller and called person. In addition, connecting the telephone apparatus to the telephone system after the user decides to accept the call (i.e. the connection means) is inherent in order to establish a communication link between the caller and called person.

Regarding claims 5-10, both Figa and Blakley teach to associate a caller's name with the identified telephone number. Further, Blakley teaches a storage means for storing a personalized list of names corresponding to the identified telephone numbers and to audibly announce the caller's name and/or number to the user.

Regarding claims 12-17, although Figa teaches to associate their caller ID concept with a standard telephone set, it is well known in the art to associate caller ID capability with other telephonic devices (i.e cordless telephones, facsimiles, etc.) and would have been obvious to incorporate with other telephonic devices lacking any criticality or showing by applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on (703) 308-5318. The fax phone numbers for the organization where this application

Application/Control Number: 10/042,686
Art Unit: 2683

Page 5

or proceeding is assigned are (703) 872-9314 for regular communications
and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this
application or proceeding should be directed to the receptionist whose
telephone number is 703-305-4700.

LEE NGUYEN
Primary Examiner
Art Unit 2683

 9/17/02

Art Unit: 2746

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with William Ritchie (#33,118) on 9/1/99.

2. The application has been amended as follows:

In the Claims:

In claim 22, line 12, after "and", "said" has been deleted.

In claim 22, line 12, after "and", --an-- has been inserted.

In claim 22, line 15, before "announcing means", "an" has been deleted.

In claim 22, line 15, before "announcing means", --said-- has been inserted.

In claim 12, line 2, after "of said", "telephone set" has been deleted.

In claim 12, line 2, after "of said", --subscriber's telephone equipment-- has been inserted.

In claim 17, line 2, after "by", "the same telephone line of said switch" has been deleted.

In claim 17, line 3, after "by", --said telephone system-- has been inserted.

3. The following is an examiner's statement of reasons for allowance:

Art Unit: 2746

Regarding claim 22, the prior art of record fails to teach loop current means connected and functioned as claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Nguyen whose telephone number is (703) 308-5249. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (703) 305-4366.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Lee Nguyen

September 17, 2002

Art Unit: 2746

DETAILED ACTION

1. This office action is responsive to the communication filed 10/13/98.
2. Claim 11 has been canceled. Claims 1-10 and 12-21 remain in prosecution.

Terminal Disclaimer

3. The terminal disclaimer filed on 10/13/98 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the U.S. Patent No. 5,526,406 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Interference

4. Applicant's request for Interference with U.S. Patent No. 5,481,594 can not be declared under 37 CFR 1.606, not [37 CFR 1.604] for the following reasons:

(B) The applicant's claims are not supported by the application disclosure which do not comply with 35 U.S.C. 112:

In claim 18, claim element 18D is not supported by the original application page 15, line 21, the current source is not a separate recording device;

claim element 18E is not supported by the original application page 13, line 22, "the searches database for a match to the collected ICLID number" does not support the claimed "a programmable table of concordance in a memory separate from the storage for the audio message, for relating the

Art Unit: 2746

location of the audio message in storage to a corresponding identifying portion of the anticipated telephone call”;

the functionality of claim element 18H is not supported by the original application, which required “suppressing a ringing signal to a called party telephone after a call is received by the unit and before the call is answered at the telephone”;

the original application also fails to support the limitation of: search the table of concordance to determine the location of the corresponding audio messages, and to play back the called party the audio message corresponding to the party from the storage through the audio output.

In claim 21, claim element 21D is not supported by the original application page 15, line 21, the current source is not a separate recording device;

claim element 21E is not supported by the original application page 13, line 22, “the searches database for a match to the collected ICLID number” does not support the claimed “a programmable table of concordance in a memory separate from the storage for the audio message, for relating the location of the audio message in storage to a corresponding identifying portion of the anticipated telephone call”;

the functionality of claim element 21L is not supported by the original application, which required “suppressing a ringing signal to a called party telephone after a call is received by the unit and before the call is answered at the telephone”;

the original application also fails to support the limitation of: search the table of concordance to determine the location of the corresponding audio messages, and to play back the corresponding

Art Unit: 2746

audio messages from the storage through the audio output while the unit is suppressing the ringing signal to the telephone, wherein the microcontroller is adapted to receive signals from the control keys to the unit in a programming mode, the unit being adapted to program the table of concordance according to user instructions when in the programming mode.

(C) The applicant was not claiming the same or substantially the same invention as claimed in the patent within 1 year after the date on which the patent was issued, 1/2/96 (35 U.S.C. 135(b); see also MPEP § 2307).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 18-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 18, claim element 18D is not supported by the original application page 15, line 21, the current source is not a separate recording device;

claim element 18E is not supported by the original application page 13, line 22, “the searches database for a match to the collected ICLID number” does not support the claimed “a programmable

Art Unit: 2746

table of concordance in a memory separate from the storage for the audio message, for relating the location of the audio message in storage to a corresponding identifying portion of the anticipated telephone call”;

the functionality of claim element 18H is not supported by the original application, which required “suppressing a ringing signal to a called party telephone after a call is received by the unit and before the call is answered at the telephone”;

the original application also fails to support the limitation of: search the table of concordance to determine the location of the corresponding audio messages, and to play back the called party the audio message corresponding to the party from the storage through the audio output.

In claim 21, claim element 21D is not supported by the original application page 15, line 21, the current source is not a separate recording device;

claim element 21E is not supported by the original application page 13, line 22, “the searches database for a match to the collected ICLID number” does not support the claimed “a programmable table of concordance in a memory separate from the storage for the audio message, for relating the location of the audio message in storage to a corresponding identifying portion of the anticipated telephone call”;

the functionality of claim element 21L is not supported by the original application, which required “suppressing a ringing signal to a called party telephone after a call is received by the unit and before the call is answered at the telephone”;

Art Unit: 2746

the original application also fails to support the limitation of: search the table of concordance to determine the location of the corresponding audio messages, and to play back the corresponding audio messages from the storage through the audio output while the unit is suppressing the ringing signal to the telephone, wherein the microcontroller is adapted to receive signals from the control keys to the unit in a programming mode, the unit being adapted to program the table of concordance according to user instructions when in the programming mode.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 5-10, 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figa et al. (U.S. 4,924,496) cited in the parent application in view of Blakley (U.S. 4,899,358) cited in the parent application.

Regarding claim 1, Figa discloses a calling party announcement apparatus in fig. 1, comprising: detecting means 12 for detecting the caller's identification signal and central processing means 18 for processing the caller's identification signal corresponding to the identity of the caller. Figa differs from claim 1 of the present invention in that the calling parties number is displayed as

Art Unit: 2746

opposed to being audibly announced as claimed. Blakley teaches in a caller announcement system to detect a calling party's identity and to audibly announce the caller's identity at the user's telephone set. With this knowledge, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the visual display technique of Figa with the audible announce concept of Blakley to indicate the caller's identity for a user with visual impairment.

Regarding claims 2-3, Figa as modified also differs from claims 2-3 of the present invention by not specifically disclosing the isolation and reconnection means as claimed. However, Blakley specifically teaches in col. 1, lines 64-67 that "the name is spoken after the called party has answered in response to ringing at the station but before a connection is completed to the caller". When providing the audible announcement concept of Blakley in a local environment, as in Figa, it would have been obvious to one of ordinary skill in the art to isolate the telephone apparatus from the telephone system in order that the caller's identity is audibly announced through the handset without the caller being aware that the user has gone "off-hook" with the telephone, and thus preventing a direct connection between the caller and called person. In addition, connecting the telephone apparatus to the telephone system after the user decides to accept the call (i.e. the connection means) is inherent in order to establish a communication link between the caller and called person.

Regarding claims 5-10, both Figa and Blakley teach to associate a caller's name with the identified telephone number. Further, Blakley teaches a storage means for storing a personalized list of names corresponding to the identified telephone numbers and to audibly announce the caller's name and/or number to the user.

Art Unit: 2746

Regarding claims 12-17, although Figa teaches to associate their caller ID concept with a standard telephone set, it is well known in the art to associate caller ID capability with other telephonic devices (i.e cordless telephones, facsimiles, etc.) and would have been obvious to incorporate with other telephonic devices lacking any criticality or showing by applicant.

Allowable Subject Matter

9. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 4, the calling apparatus with the components as claimed in claims 1-4 in which loop current means connected and functioned as claimed is not taught or suggested in the prior art of record.

Response to Arguments

10. Applicant's arguments with respect to claims 1-10 and 12-21 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2746

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Nguyen whose telephone number is (703) 308-5249. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (703) 305-4366.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications intended for entry)

Or:

(703) 305-9508, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Application/Control Number: 08/660,814

Page 10

Art Unit: 2746

Lee Nguyen

September 17, 2002